

REMARKS

In the Office Action, Paper No. 9, dated August 3, 1999, the Patent Examiner rejected claims 1, 67, 113, 177-190 under the judicially created doctrine of non-statutory obvious double patenting over the claims of U.S. Patent 5,862,223 issued to Walker, et al. (hereinafter the "*Walker, et al.* patent"). In addition, the Patent Examiner rejected claims 1, 67, 113, 177-179 and 185 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particular point out and distinctly claim the subject matter which applicants regard as the invention by leaving out essential details that are objects of the invention, such omission amounting to a gap between the elements.

In response the Patent Examiner's rejections, the applicants have filed a terminal disclaimer to expedite prosecution of the present application. In addition, the applicants have amended claims 1, 67, 113, 177-179, 181, 183, 185 and 187-189 to recite more clearly the subject matter of the invention and added new claims 191 and 192. No new matter is introduced by this amendment.

A. Non-Statutory Double Patenting Rejection of Claims 1, 67, 113, 177-190.

The Patent Examiner rejected claims 1, 67, 113, 177-190 under the judicially created doctrine of non-statutory obviousness type double patenting over the claims of the *Walker, et al.* patent. While the applicants do not agree with this rejection, particularly with respect to claims 177-190, a Terminal Disclaimer is being filed concurrently herewith solely to expedite prosecution of the present application.

B. Section 112, Second Paragraph, Rejection of Claims 1, 67, 113, 177-179 and 185.

The Patent Examiner rejected claims 1, 67, 113, 177-179 and 185 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point

out and distinctly claim the subject matter which applicants regard as the invention by leaving out essential details that are objects of the invention, such omission amounting to a gap between the elements. The applicants respectfully traverse the Patent Examiner's rejection of these claims.

The Patent Examiner makes a general and vague reference to the objects of the invention provided in the specification as the basis for his assertion that essential details of the invention must include "an apparatus/method for expert matching," "a database that contains an address of selected expert," "means for selecting the end user request for evaluation," and "means for transmitting at least a portion of the end user request to an expert based on the end user request." See, Office Action, Paper No. 9, pages 8-9. However, the Patent Examiner provides no specific support for this assertion or any specific citation to the applicants' specification as to this determination. Therefore, any specific basis or support for the Patent Examiner's assertion is unclear. The applicants contend that the Patent Examiner's rejection of the claims based on this vague reference and unsupported assertion is improper for at least three reasons.

First, as previously pointed out by the Court of Claims and Patent Appeals (CCPA) in its ruling in *In re Borkowski*, 164 USPQ 642 (CCPA 1970), the Patent Examiner's manner of determining the applicants' invention is improper. In this ruling, the CCPA stated that:

The examiner's approach to determining whether appellant's claims satisfy the requirement of §112 appears to have been to study appellant's disclosure to formulate a conclusion as to what he (the examiner) regards as the broadest invention supported by the disclosure, and then determine whether applicants' claims are broader than the examiner's conception of what 'the invention' is. We cannot agree that §112 permits such an approach to claims.

In re Borkowski, 164 USPQ at 645-646. In addition, when rejecting a claim under the second paragraph of 35 USC § 112, the Patent Examiner must establish that one of ordinary skill in the art, when reading the claims in light of the supporting specification, would not have been able to ascertain with a reasonable degree of precision and particularity the particular area set out and circumscribed by the claims. *Ex parte Wu*, 10 USPQ2d 2031, 2033 (BPAI 1989). The applicants respectfully submit that the Patent Examiner has incorrectly defined and limited the applicants' invention, particularly with respect to claims 177-190, which are directed to approval of a first expert by one or more experts of higher qualifications. Moreover, the Patent Examiner has not established that a person of ordinary skill in the art would not have been able to ascertain with a reasonable degree of precision and particularity the particular area set out and circumscribed by the claims.

Second, the Patent Examiner incorrectly points to the objects of the invention provided in the specification in his determination of the essential details of the applicants' invention. The content of the applicants' specification is not to be used as evidence that the scope of the claims is inconsistent with the subject matter that the applicants regard as their invention. *In re Ehrreich*, 200 USPQ 504 (CCPA 1979). *See also*, Manual of Patent Examining Procedure, 2172. Moreover, since the patent law provides for the amendment of claims during prosecution, "the reference to 'particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention' in the second paragraph of 35 USC 112 does not prohibit the applicant from changing what he 'regards as his invention' (i.e., the subject matter on which he seeks patent protection) during the pendency of his application." *In re Saunders*, 170 USPQ 213, 220 (CCPA 1971), *cited in In re Wertheim*, 191 USPQ 90, 97 (CCPA 1976). Thus, that claims are interpreted in light of the specification does not mean that a specific limitation found in the specification must read into all of the claims, *Raytheon Co. v. Roper Corp.*, 220 USPQ 592, 597 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 835 (1984), and the

applicants are entitled to claims as broad as the prior art and their disclosure will allow, *In re Rasmussen*, 211 USPQ 323, 326 (CCPA 1981). Thus, a claim may be broader than any specific embodiment disclosed in the specification. *Id.* Again, the applicants respectfully submit that the Patent Examiner has incorrectly defined and limited the applicants' invention and that the Patent Examiner is improperly, and without providing any specific support, requiring elements be placed into the claims. Such a requirement creating limitations in the claims not necessary for patentability of the claims.

Third, while the applicants disagree with Patent Examiner's assertion that essential details of the invention include "an apparatus/method for expert matching," "a database that contains an address of selected expert," "means for selecting the end user request for evaluation," and "means for transmitting at least a portion of the end user request to an expert based on the end user request," the applicants respectfully point out the previously pending claims 1 and 113 each recite the specified database and means for transmitting. More specifically, claim 1 recites a database storing a plurality of expert qualifications, each expert qualification being associated with an expert address, and a "means for transmitting at least a portion of the end user request to the address corresponding to the identified expert." Similarly, claim 113 recites a database for storing a plurality of expert qualifications, each expert qualification associated with an expert address, and a "means for transmitting at least a portion of the end user request to the identified expert address." Despite already having these recitations, the applicants have further amended claims 1 and 113 to recite more clearly that the claimed inventions are directed to a computer implemented expert matching apparatus having a database with stored addresses corresponding to one or more experts.

With regard to claim 67, the applicants note that previously pending claim 67 already recites a "means for selecting the end user request for evaluation" and a

“means for transmitting at least a portion of the end user request to and expert based on the end user request.” Specifying an expert to receive the transmission results in a designation of the destination of the transmission sufficient for patentability of the claim. A person of ordinary skill in the art would understand the scope of claim 67 when the claim is read in light of the specification and, as a result, claim 67 meets the requirements of 35 USC § 112, second paragraph. *North American Vaccine, Inc. v. American Cyanamid Co.*, 28 USPQ 1333 (Fed. Cir. 1993), *cert. denied*, 114 S.Ct. 1645 (1994). The Patent Examiner has improperly read other limitations as being required in claim 67. The applicants have amended claim 67, however, to recite more clearly the expert matching nature of the claimed invention.

The Patent Examiner also rejected claims 177-179 and 185 under 35 U.S.C. § 112, second paragraph, as being incomplete for omitting an essential element, such omission amounting to a gap between the elements. While the applicants disagree with the Patent Examiner’s assertion, the applicants have amended independent claims 177-179 and 185 to recite more clearly that each of the claimed methods is directed to computer implemented expert matching method. As a result of the applicants’ amendments to claims 177-179 and 185, the Patent Examiner’s rejection of these claims is respectfully traversed.

Please note that while the applicants have amended claims 1, 67, 113, 177-179 and 185 for purposes of overcoming the Patent Examiner’s rejections under 35 USC § 112, the amendments do not alter or further limit the scope of the these claims in any manner or fashion.

C. Newly Added Claims.

The applicants have added new independent claims 191 and 192. New independent claim 191 includes all of the limitations of claim 1 along with a “means for selecting the end user request for evaluation.” Similarly, new independent

claim 192 includes all of the limitations of claim 113 along with a “means for selecting the end user request for evaluation.”

Both of the new independent claims 191 and 192 are directed to a computer implemented expert matching apparatus and include an address stored in the database and corresponding to an expert. Likewise, both of the new independent claims 191 and 192 include a “means for selecting the end user request for evaluation” and a “means for transmitting at least a portion of the end user request to” an address of an identified expert. Therefore, at a minimum, the new independent claims 191 and 192 include all of the elements asserted, albeit incorrectly, by the Patent Examiner to be essential for the claims. As a result, while the applicants disagree with the Patent Examiner’s assertions, as previously discussed above, the new independent claims 191 and 192 satisfy the requirements set forth by the Patent Examiner in the Office Action, Paper No. 9, and the Patent Examiner is respectfully requested to allow these claims.

D. Conclusion.

For the foregoing reasons it is submitted that all of the claims are now in condition for allowance and the Patent Examiner’s early re-examination and reconsideration are respectfully requested.

Alternatively, if there remains any question regarding the present application or any of the cited references, or if the Patent Examiner has any further suggestions for expediting allowance of the present application, the Patent Examiner is cordially requested to contact Scott Allison at telephone number (203) 905-6548 or via electronic mail at sallison@walkerdigital.com.

E. Petition for Extension of Time to Respond.

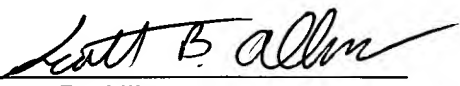
Applicants hereby petition for a three-month extension of time with which to respond to the Office Action. Please charge \$ 870.00 for this petition to our Deposit

Account No. 50-0271. Please charge any additional fees that may be required for this Response, or credit any overpayment to Deposit Account No. 50-0271.

If an extension of time is required, or if an additional extension of time is required in addition to that requested in a petition for an extension of time, please grant a petition for that extension of time which is required to make this Response timely, and please charge any fee for such extension to Deposit Account No. 50-0271.

Respectfully submitted,

February 2 , 2000
Date



Scott B. Allison
Attorney for Applicants
Registration No. 38,370
sallison@walkerdigital.com
Walker Digital Corporation
One High Ridge Park
Stamford, CT 06905-1325
(203) 905-6548